

### **REMARKS**

Claims 1 – 12, 14 – 34 and 36 – 40 are now pending in the application. Claims 1, 12, 21, 27, 29, 31 and 36 have been amended. Claims 13 and 35 has been cancelled. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein.

### **ALLOWABLE SUBJECT MATTER**

The Examiner states that claims 39 and 40 are allowed. Applicants acknowledge the Examiners indication that claims 6 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants note that claim 26 was not specifically rejected or otherwise addressed in the latest Office Action. Applicants request the Examiner to clarify the status of claim 26. Applicants wish to preserve the opportunity to amend claims 6 and 20 at a later time.

### **SPECIFICATION**

The specification has been amended to correct a reference numeral error. Specifically, in paragraph [0031], reference numerals 60A – 60C have been replaced with reference numerals 120A – 120C to correspond with the drawings.

**REJECTION UNDER 35 U.S.C. § 102**

Claims 21 – 25 and 27 – 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Drohman (U.S. Pat. No. 2,589,234). This rejection is respectfully traversed.

At the outset, Applicants note that claim 21 has been amended to recite, “at least one bit holder pivotally connected to said hinge at a first side, said at least one bit holder including a foot portion extending from a second side opposite said hinge in a direction away from said hinge”. Applicants respectfully submit that Drohman does not teach or suggest such features. Drohman at best provides a tool case including two halves 10, 11 of a clam shell case hinged along adjacent edges 12 and 12a and pivoted about a hinge pin 13. Drill bit panels 16 and 16a have a ledge 17 at its upper edge including a series of drill sockets 18 of graduated diameter. A stop key 29 is rotatably carried by the hinge 13 in the plane of slots 25 and 25a in the panels 16 and 16a. The extremities of the key 29 have stops or tongues 30 which are adapted to engage the face of the panels 16 and 16a adjacent the ends of the slots 25. As illustrated in FIGS. 1 and 3, the drill bit panels 16 and 16a define uniform side surfaces opposite the hinge, that are adapted to lie directly adjacent to the side walls of the clam shell case. Therefore, Drohman fails to provide at least one bit holder including a foot portion extending from a second side surface opposite the hinge in a direction away from the hinge. Accordingly, reconsideration and withdrawal of the rejection of claims 21 – 25 are respectfully requested.

Applicants note that claim 27 has been amended to recite “a bit holder having an outer sleeve coupled to and supported by a frame portion, said frame portion disposed

within said body cavity and directly pivotally connected to said hinge.” Applicants respectfully submit that Drohman does not teach or suggest such features. The drill bit panels 16 and 16a of Drohman include intermediate supports 20 and 20a for providing lateral support of the drill bits. As recited in Drohman, the intermediate supports 20 and 20a can be consolidated with either the upper or lower supports or omitted entirely (Col. 3, Lines 7 – 10). The intermediate supports 20 and 20a are not directly pivotally connected to the hinge. Therefore, Drohman does not provide an outer sleeve coupled to a frame portion wherein the frame portion is directly pivotally connected to the hinge, as claimed.

With regard to claim 30, the Examiner has noted that the first and second radial support members being axially offset from each other may be ambiguous. As a result, Applicants have amended claim 29 to more clearly define each bit receiving portion including a first and second radial wall portion. Accordingly, reconsideration and withdrawal of the rejection of claims 27 – 30 are respectfully requested.

#### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1, 2, 5, 9, 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Drohman in view of Budert (U.S. Pat. No. 6,547,077). This rejection is respectfully traversed.

Applicants note that claim 1 has been amended to recite “said front housing portion defining a passage for viewing the bits in said closed position.” Applicants respectfully submit that neither Drohman nor Budert teach or suggest such a feature. Applicants note that the case of Drohman provides two solid halves 10 and 11.

Similarly Budert provides a front wall part 2, a rear wall part 3 and a receiving device 4 for holding drill bits 11. The front wall part 2 includes a window 31 for viewing the receiving device 4 in the closed position (FIG. 1). The window 31 also produces a visually attractive and individual design in the front wall 2 if a receiving device 4 is of a different color. The area can also be used for company logos (see e.g., Col. 6, Lines 20 – 26). As specifically noted in Budert, the front wall must be removed to view the bits 11. Specifically, “the wall parts 2, 3 can be detached again easily, since this is a releasable type of connection. This also enables the tool holder 1 to be displayed at the point of sale, for example with the front wall part 2 lifted off, so that the user or the potential purchaser can look at the drill bits 11 arranged in the receiving device 4”. Col. 3, Lines 56 – 62. The storage container of the present invention alleviates this step by allowing the user or potential purchaser to view the drill bits through the passage without any manipulation of the container. Accordingly, reconsideration and withdrawal of the rejection of claims 1, 2, 5, 9, 10 and 11 are respectfully requested.

Claims 3, 4, 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Drohman in view of Budert, and further in view of Huot (U.S. Pat. No. 2,564,601). This rejection is respectfully traversed. Huot at best provides a drill holder casing 10 having a plurality of drill holding members 15 mounted upon rods 14 for swinging movement. Applicants note that while the bit holders of the present invention each extend upward respective distances from a bottom of the body cavity (see e.g. FIG. 8 of the present disclosure), the drill holding members 15 of Huot each extend upward from different areas in the body cavity (See e.g., FIG. 2). Nonetheless,

Applicants respectfully submit that the amendments and discussion related to claim 1 above places claims 3, 4, 7 and 8 in condition for allowance.

Claims 12 – 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Drohman in view of Huot. This rejection is respectfully traversed. Applicants note that claim 12 has been amended to include the limitation of “wherein cutouts are defined in said front and rear housing portion to accommodate said at least two hinge arms of said front, rear and middle bit holders.” Applicants submit that neither Drohman nor Huot teach or suggest such a feature. While Drohman shows cutouts for two bit holders 16 and 16a, there is no suggestion of how a third “middle” bit holder could be accommodated. Accordingly, reconsideration and withdrawal of the rejection of claims 12 – 18 are respectfully requested.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Drohman in view of Riess (U.S. Pat. No. 4,934,530). This rejection is respectfully traversed. Applicants note that original claim 19 includes, “wherein said plurality of bit holders include laterally extending ridges formed on a side opposite from said hinge, said ridges facilitating a gripping action on said bit holders for rotating said bit holders about said hinge.” Riess does not teach or suggest laterally extending ridges formed on the bit holders on a side opposite from the hinge. Instead, Riess provides a distinct component (feature 8) which is pivotally connected to the stand part 1 to improve the fanning out of the receptacles 3, 4.

Riess at best discloses a standing case having a stand part 1 which normally rests with its bottom on the workbench and has a cover part 2 pivotally connected therewith. Two receptacles 3, 4 are swingably mounted on a pivot shaft 5. To facilitate

the fanning out of the receptacles 3, 4 and thereby facilitate removal of the tools, the housing is provided at its side opposite the rear wall 1.1 with a closure part 8 which is pivotally connected to the stand part 1 and can be swung out in the same direction as the receptacles 3, 4. The closure part 8 is formed from a rectangular cover plate with two lateral flanges 8.1, see FIGS. 1 and 4.

The Examiner states that Riess discloses ridges on the portion of the container which is engaged by the hand of the user to improve the grip on that portion. The Examiner appears to be referring to detail shown in FIG. 1 leftward of reference numeral 7. It appears that this unmarked feature may be provided to simply grip the cover 2.

The Examiner states "as the portion of the drill bit holder that is most likely to be engaged by the user of Drohman is the bit lateral side of the bit holder, it would have been obvious to one of ordinary skill in the art to modify the lateral side of the bit holders of Drohman with the ridges as taught by Riess to improve the grip on the tool holder". Applicants disagree. Applicants argue that at best Riess may show a gripping detail on the cover 2 of the case. Riess makes no teaching or suggestion to provide the bit holders with a gripping detail, rather, the closure part 8 is used "to facilitate the fanning out of the receptacles 3, 4". Because the closure part 8 is used to facilitate the fanning out of the receptacles 3, 4 there is no motivation in Riess to apply a gripping feature (such as the gripping feature appearing to be shown in FIG. 1) to the receptacles 3, 4. Applicants further argue that because there is no motivation in Riess to apply the gripping feature to the bit holders, it would not be obvious to use a feature (gripping detail) disclosed on a cover of a tool case from one reference (Riess) and apply that feature to a distinct component (bit holders) of another reference (Drohman).

Accordingly, reconsideration and withdrawal of the rejection of claims 19 and 20 are respectfully requested.

Claims 31 – 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Drohman in view of Huot, and further in view of Eldridge, Jr. (U.S. Pat. No. 4,596,329). This rejection is respectfully traversed. Applicants have amended claim 31 to include, “wherein each of said bit receiving portions corresponds to a pair of common bit size identifiers disposed proximate said bit receiving portions, one of said pair disposed on each of said front sides of said plurality of bit holders, the other of said pair disposed on each of said rear sides of said plurality of bit holders.” Applicants submit that Drohman, Huot and Eldridge, Jr., fail to teach or suggest such features.

Eldridge, Jr., at best provides a surgical holding device 10 having a top 11 and a bottom 13. An elongate magnetizable strip 34 is mounted upon the top surface 12 adjacent to one of the sidewalls 14. Another magnetizable strip 36 is positioned adjacent to one of the bottom sidewalls 18 and affixed to the bottom surface 16. Pivotaly mounted between the top surface 12 and the bottom surface 16 is a planar substrate 22. The substrate 22 is formed of a thin coating material 31 which envelops a planar magnet 32. The substrate 22 can be pivotally moved from a first position (FIG. 2), to a second position (FIG. 3). The magnetizable strip 34 holds the substrate 22 and provides a spacing between the upper surface 26 of the substrate 22 and the top surface 12. The space is of a sufficient size to permit blades 30 to be retained on the upper surface 26 (FIG. 2) and also lower surface 24 (FIG. 3). Because the opposite surfaces 24 and 26 are operable to retain distinct blades, unique identifiers are provided

on each surface 24 and 26. Specifically, identifiers “1 – 14” are used for surface 26 and identifiers “15 – 28” are used for surface 24 (FIGS. 2 and 3).

The configuration of the present invention is distinct from Eldrige, Jr. The present invention provides a pair of common bit size identifiers disposed proximate to each of said bit receiving portions, one of said pair disposed on each of said front sides of said plurality of bit holders, the other of said pair disposed on each of said rear sides of said plurality of bit holders. Such a configuration makes it convenient for a user to identify the same bit from either the front or the rear side of a bit receiving portion. Accordingly, reconsideration and withdrawal of the rejection of claims 31 – 34 are respectfully requested.

Claim 35 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Drohman in view of Huang (U.S. Pat. Publ. No. 2003/0085141). Claim 35 has been cancelled and therefore this rejection has been rendered moot.

Claims 36 – 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Drohman in view of Hallee (U.S. Pat. Publ. No. 2004/0144671). This rejection is respectfully traversed. Claim 36 has been amended to include “said front and rear housing portions each including protruding sections extending on first sides to said second common plane and extending on second sides to respective protruding planes, said protruding planes defined parallel to and outboard of said front face and said rear face, respectively”. Applicants respectfully submit that Drohman nor Hallee teach or suggest such features.

Hallee at best provides a casing 12 having a band of elastomeric material 44 defining a flat tread pattern 46 on each short sides 20 and 22 of the case 12. See



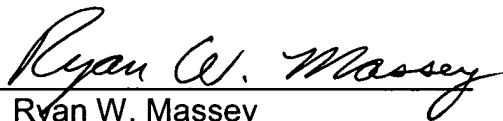
FIGS. 1 and 5. The elastomeric material 44 of Hallee does not extend outboard of the front and rear face of the casing 12. The present invention provides structure for achieving a wide footprint while standing on a bottom face (See e.g., FIGS. 1 and 2 of the present disclosure). A wide footprint makes the container of the present invention significantly more stable than the relatively narrow footprint provided by the elastomeric material 44 of Huang. Accordingly, reconsideration and withdrawal of the rejection of claims 36 – 38 are respectfully requested.

#### CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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